

App. No. 08/869,872
Response Dated October 30, 2006
Reply to Final Office Action of June 29, 2006

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REMARKS/ARGUMENTS

This paper is submitted in response to an Office Action dated June 29, 2006. Prior to the issuance of the Office Action, claims 26-47 were pending, with claims 1-25 and 48 having previously been canceled. Independent claims 26, 33, 40, and 47 are currently amended in this response. Dependent claims 27, 28, 34, 35, 41, and 42 are canceled in this response. Accordingly, claims 26, 29-33, 36-40, and 43-47 remain pending.

The Examiner was kind enough to grant applicant's attorney a telephonic interview on Monday, October 30, 2006. Both applicant and applicant's attorney are grateful to the Examiner for taking the time to review a proposed amendment submitted by applicant's attorney, for discussing the case with applicant's attorney, and for identifying allowable subject matter as recited in the amended claims.

CLAIMS REJECTED UNDER 35 U.S.C. § 102

Claims 26-47 were rejected under 35 U.S.C. § 102(b) as being anticipated by Microsoft Money User's Guide, Version 2.0, hereinafter referred to as "Microsoft Money" in view of "Making the Most of Microsoft Money," hereinafter referred to as "Money 2." Applicants traverse the rejection, but also amend independent claims 26, 33, 40, and 47 to further distinguish over the reference -- or references -- cited.

To reduce the number of issues to be considered by the Examiner, in this response applicant has not necessarily responded specifically with regard to the rejections of each of dependent claims 29-32, 36-39, and 43-46. These claims depend from and apply additional limitations to the respective independent claims from which they depend. Accordingly, these

App. No. 08/869,872
Response Dated October 30, 2006
Reply to Final Office Action of June 29, 2006

claims are patentable for at least the same reasons as the independent claims from which each depends. Applicant's lack of a response to any specific rejection of the dependent claims does not indicate that applicant agrees with such rejections or waives his rights to respond to these rejections at a later time. Similarly, applicant's lack of response to any particular grounds for rejection, even if applicant has responded to other grounds for rejection of the same claims, does not indicate that applicant agrees with the grounds for rejection, or that applicant waives his right to respond to such grounds for rejection at a later time.

Respectfully, the rejection under 35 U.S.C. § 102(b) should be withdrawn as to the claims for at least two reasons. First, the two references were improperly combined in asserting a rejection under § 35 U.S.C. § 102(b) (hereinafter § 102(b)). Second, and as clarified by the amendments to the independent claims, even considering "Microsoft Money" in view of "Money 2," the combined references fail to teach or suggest each and every element recited in each of the independent claims.

First, the references "Microsoft Money" and "Money 2" were improperly combined in presenting a § 102(b) rejection. By law, a claim can be rejected under § 102(b) only when the claimed invention was taught by a single publication:

A person shall be entitled to a patent unless –

* * *

(b) the invention was patented or described in *a printed publication* in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States

(Emphasis added.) In addition, MPEP § 2131 expressly mandates that, to support a § 102(b) rejection, a single reference must teach every element of a rejected claim:

App. No. 08/869,872
Response Dated October 30, 2006
Reply to Final Office Action of June 29, 2006

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CENTRAL FAX CENTER
OCT 30 2006

TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001) (claim to a system for setting a computer clock to an offset time to address the Year 2000 (Y2K) problem, applicable to records with year date data in "at least one of two-digit, three-digit, or four-digit" representations, was held anticipated by a system that offsets year dates in only two-digit formats). See also MPEP § 2131.02. *"The identical invention must be shown in as complete detail as is contained in the . . . claim."* *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

(Emphasis added.) The Office Action combines two references in order to support the § 102(b) rejection, and thus violates the Office's own rules in rejecting the subject application.

Moreover, the § 102(b) rejection's reliance on multiple rejections does not fit within the narrowly circumscribed exceptions allowing more than one reference to be combined within a § 102(b) rejection. MPEP § 2131 does state that, "in some circumstances, it is permissible to use multiple references in a 35 U.S.C. 102 rejection. See MPEP § 2131.01." However, this rejection does not fit the enumerated exceptions listed in MPEP § 2131.01:

2131.01 Multiple Reference 35 U.S.C. 102 Rejections

Normally, only one reference should be used in making a rejection under 35 U.S.C. 102. However, a 35 U.S.C. 102 rejection over multiple references has been held to be proper when the extra references are cited to:

- (A) Prove the primary reference contains an "enabled disclosure;"
- (B) Explain the meaning of a term used in the primary reference; or
- (C) Show that a characteristic not disclosed in the reference is inherent.

App. No. 08/869,872
Response Dated October 30, 2006
Reply to Final Office Action of June 29, 2006

Respectfully, the combination of Microsoft Money and Money 2 does not fit within any of these exceptions. Moreover, the Office Action has not even attempted to assert that the combination of references fits one of these exceptions to be permissible under § 102(b). The Office Action includes no statement or suggestion that Money 2 was needed to show that Microsoft Money contained an enabled disclosure, that Money 2 was needed to explain a term used in Microsoft Money, or that Money 2 shows a characteristic not shown by Microsoft Money was inherent. Thus, in combining references and not asserting an exception as to why more than one reference could be combined, applicant respectfully asserts that the § 102(b) was improperly submitted by the Office Action, and requests that the rejection be withdrawn.

In addition, the Office Action's incorrect combination of references is acknowledged in the text of the Office Action:

"Microsoft Money differs from the claim in that it does not disclose receiving an electronic financial statement by which to receive a payee name. However, "Money 2" at page 38 includes instructions entitled, "Step 3: Reading Statements: Entering Downloaded transactions" . . . *It would have been obvious to one of ordinary skill in the art to modify* Microsoft Money to permit electronically downloaded bank transactions and provide the received payee names so as [to] eliminate the need for manually inputting payee names for each transaction as specifically taught by Money 2."

(Office Action, Page 3; emphasis added). Respectfully, the need to combine references to overcome a shortcoming in the primary reference, to say nothing of the invocation of the obviousness standard of 35 U.S.C. § 103, makes clear that the claims were not properly rejected under § 102(b), and the § 102(b) rejected should be withdrawn.

Second, because the Office Action does not make out a proper § 102(b) rejection, if for the sake of discussion the rejection was treated as a rejection under 35 U.S.C. § 103, the cited

App. No. 08/869,872
Response Dated October 30, 2006
Reply to Final Office Action of June 29, 2006

references still fail to make out a valid *prima facie* obviousness rejection. The secondary reference, Money 2, fails to overcome the shortcomings of the primary reference, Microsoft Money. If anything, the combined references teach away from what is recited in the claims. Moreover, applicant respectfully submits that the references themselves make plain that no person of ordinary skill in the art at the time the invention was made would have found motivation to combine the references at all.

Neither reference, alone or in combination, teaches several elements of the claimed invention. For example, and for the convenience of the Examiner, claim 26 as amended is reproduced below:

26. (Currently Amended) A method for automatically substituting ~~renaming~~ payee names received from the electronic transfer of financial data when displayed in ~~into~~ a personal financial management program, comprising the steps of:

- receiving an electronic financial statement transmitted from a financial services provider, wherein the electronic financial statement comprises one or more transaction entries, each transaction entry comprising an original a-payee name used by the financial services provider in the electronic financial statement and a transaction amount;

- receiving a user command associating the original a-received payee name with a preferred payee name assigned by a user for use in the personal financial management program;

- creating a data structure that comprises a dummy payee table comprising a dummy field;

- moving the original received payee name to the dummy field;

- associating linking the original received payee name in the dummy field to the preferred payee name in the dummy field and indicating an assignment of the preferred payee name;

- selecting an individual transaction for display, searching the dummy payee table to determine if there exists a match for the original payee name that indicates the assignment of the preferred payee name; and

- upon determining there exists in the dummy payee table a match for the original payee name and the assignment of the preferred payee name, automatically displaying the preferred payee name of the associated original received payee name instead for each occurrence of the associated original

App. No. 08/869,872
Response Dated October 30, 2006
Reply to Final Office Action of June 29, 2006

received-payee name in the electronic financial statement listing the associated original payee name when received from the financial services provider upon determining there does not exist a match, searching an active payee table to locate and display an original payee name.

Neither Microsoft Money nor Money 2 teaches a number of these limitations. For example, the cited references teach "associating the original payee name in the dummy field to the preferred payee name in the dummy field and indicating an assignment of the preferred payee name." Similarly, the cited references do not teach that, "selecting an individual transaction for display, searching the dummy payee table to determine if there exists a match for the original payee name that indicates the assignment of the preferred payee name." Also, the cited references do not teach, "upon determining there exists in the dummy payee table a match for the original payee name and the assignment of the preferred payee name, automatically displaying the preferred payee name of the associated original payee name instead of the associated original payee name when the user accesses an individual transaction in the electronic financial statement listing the associated original payee name," in which the original payee name is the payee name used by the financial services provider and the preferred display name is assigned by a user. Finally, the cited references do not teach, "upon determining there does not exist a match, searching an active payee table to locate and display an original payee name."

In the passages relied upon by the Office Action in Microsoft Money, the cited reference describe the ability to assign a "shortcut" to reduce the amount of typing for designating a payee. Microsoft Money teaches that, when a user is "used to referring to a payee by an abbreviated name," the user "can make that name a shortcut for the payee" such that when the user "type[s] in a shortcut in a transaction, the full name is entered." (Microsoft Money, page 124.) Microsoft Money uses an example where, for a payee that is generally known as "City Power & Light," the

App. No. 08/869,872
Response Dated October 30, 2006
Reply to Final Office Action of June 29, 2006

user can assign a shortcut of "CPL" to save the user having to type "City Power & Light" upon seeking to make or log a payment to "City Power & Light."

The Office Action equates the shortcut "CPL" as a "received payee name" which results in the substitution of "City Power & Light" as the "preferred payee name." (Office Action, Page 2, Paragraph 8, through Page 3, Paragraph 4).

Claim 26 as amended, however, clarifies the distinction of the claim over the cited reference by specifying that "the original payee name" is "the payee name used by the financial services provider in the electronic financial statement," and "the preferred payee name" is "assigned by a user for use in the personal financial management program." Accordingly, claim 26 recites just the opposite of what the Office Action asserts the reference states. The Office Action relies on Microsoft Money as authority for replacing the *user-assigned shortcut* "CPL" as the *received* payee name for which "City Power & Light," with the *preferred* payee name *used by a financial services provider*.

However, the amendments clarify that claim 26, for example, recites just the opposite. Using the example from the reference, according to claim 26, the preferred payee name is that "assigned by a user for use in the personal financial management program," thus the preferred payee name would be CPL. The original payee name would be that "used by the financial services provider in the electronic financial statement," City Power & Light." According to claim 26, which recites "automatically displaying the preferred payee name of the associated original payee name instead of the associated original payee name when the user accesses an individual transaction in the electronic financial statement listing the associated original payee name," the preferred payee name "CPL" would be automatically displayed when a user accesses

App. No. 08/869,872
Response Dated October 30, 2006
Reply to Final Office Action of June 29, 2006

a transaction listing the original payee name "City Power & Light." By displaying the user's assigned preferred payee name instead of the original payee name, the recited invention does the opposite of what the Office Action describes Microsoft Money teaches.

Money 2 does not teach the opposite process, and thus does not make up for the shortcoming of Microsoft Money. The Office Action relies on Money 2 for the possibility of downloading an electronic financial statement. Money 2 teaches this element, but fails to make up for the shortcoming of Microsoft Money. Accordingly, the combined references do not make out a *prima facie* case of obviousness.

Furthermore, the references actually teach away from what is recited by claim 26. Because the reference teaches that the user-assigned payee name is the received or original name that is replaced with the preferred name, which is the name used by the financial institution, the reference teaches diametrically away from what is recited by claim 26. By teaching the opposite of what claim 26 recites – replacing the user-assigned preferred payee name with the original payee name instead of displaying the user-assigned preferred payee name in place of the original payee name, respectively – the reference teaches away from what is recited in the claims.

Last, there would have been no motivation to combine the cited references to attempt to reach the invention recited by claim 26. Respectfully, in the passages of the references cited by the Office Action, the manifest motivation behind the references is in saving the user from additional typing. As previously described, the section of Microsoft Money that teaches replacing the user-assigned shortcut or "received payee name" with the longer "preferred payee name" to save the user having to type the preferred payee name. Similarly, as cited by the Office Action, Money 2 teaches "that it lets you electronically download transactions directly from your

App. No. 08/869,872
Response Dated October 30, 2006
Reply to Final Office Action of June 29, 2006

financial institutions Simply put, "no more typing transactions," or [w]ith Online Banking, you can stop typing." (Money 2, page 38). The object of neither reference is to allow a user to label transactions as the user desires by "automatically displaying the preferred payee name of the associated original payee name instead of the associated original payee name when the user accesses an individual transaction in the electronic financial statement listing the associated original payee name" as recited in claim 26. Because the references are concerned with saving typing, and replacing a user-assigned shortcut payee name with an original payee name instead of the opposite recited by claim 26, there would be no motivation to combine the references.

Thus, for the reasons stated, even recasting the Office Action as a rejection under 35 U.S.C. § 103, the Office Action fails to make out a *prima facie* case on which to reject the claims. Accordingly, applicant respectfully requests entry of the amendment to claim 26 and that the rejection, cast as a § 102(b) or a § 103 rejection, be withdrawn against claim 26. Applicant thus requests that claim 26 be allowed.

In the interest of saving the Examiner's time, applicant reincorporates the foregoing remarks regarding the patentability of claim 26 with respect to claims 33, 40, and 47. In each claim, it should be noted that the preferred payee name, assigned by a user, is displayed instead of an original payee name used by a financial services provider, instead of the opposite as taught by the references. Accordingly, applicant respectfully requests entry of the amendments, withdrawal of the rejections, and allowance of claims 33, 40, and 47.

Dependent claims 29-32, 36-39, and 43-46 depend from and apply additional limitations to the respective independent claims from which each depends. Thus, dependent claims 29-32, 36-39, and 43-46 are allowable for at least the same reasons as the respective independent claims

App. No. 08/869,872
Response Dated October 30, 2006
Reply to Final Office Action of June 29, 2006

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OCT 30 2006

as previously asserted. Accordingly, applicant respectfully requests withdrawal of the rejections, and allowance of the claims.

CONCLUSION

In view of the foregoing amendments and remarks, all pending claims are believed to be allowable and the application is in condition for allowance. Therefore, a Notice of Allowance is respectfully requested. Should the Examiner have any further issues regarding this application, the Examiner is requested to contact the undersigned attorney for the applicant at the telephone number provided below.

Respectfully submitted,

MERCHANT & GOULD P.C.



Frank J. Bozzo
Registration No. 36,756
Direct Dial: 206.342.6294
(FJB/ab)

MERCHANT & GOULD P.C.
P. O. Box 2903
Minneapolis, Minnesota 55402-0903
206.342.6200

